

REMARKS

The present application was filed on June 29, 2001 with claims 1-39. Claims 1, 21, 25 and 39 are the independent claims.

In the outstanding Office Action dated August 21, 2007, the Examiner rejected claims 1-39 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,857,020 to Chaar et al. (hereinafter “Chaar”).

Applicants have amended independent claims 1, 21, 25 and 39 solely to provide a proper antecedent basis for certain claim limitations. These amendments are for clarification only and are not believed to require further consideration and/or search. Consequently, Applicants seek entry of the present amendments pursuant to 37 CFR 1.116(b) in order to place the application in condition for allowance or at least in better form for appeal. Applicants respectfully request reconsideration of the present application in view of the amendments above and the remarks below.

With regard to the §102 rejection, Applicants initially note that MPEP §2131 specifies that a given claim is anticipated “only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference,” citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, MPEP §2131 indicates that the cited reference must show the “identical invention . . . in as complete detail as is contained in the . . . claim,” citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

In arguing that Chaar meets the limitations of claim 1, the Examiner contends that the recited agent module and distributed element are met by Chaar’s SMO and SLA manager, respectively. The Examiner then argues that the limitation of claim 1 wherein a command is executed on the at least one distributed element by the at least one agent module located in the at least one distributed element is met by column 8, lines 30-40 of Chaar. This portion of Chaar not only fails to meet this limitation of claim 1, but instead teaches away by disclosing a technique wherein the SLA manager determines and executes service management action plans.

Moreover, in formulating the rejection of claim 1, the Examiner has failed to indicate the section of Chaar which is believed to disclose the limitation directed to measuring at least one

service level of at least one distributed element of the IT system in terms of one or more business metrics based on the electronic contract and based at least in part on input received from at least one agent module located in the at least one distributed element.

Accordingly, Applicants respectfully submit that the present Office Action fails to comply with 37 CFR 1.104(c)(2) (“In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.”).

Thus, in the event the present application is not considered to be in condition for allowance responsive to the remarks made herein, Applicants respectfully request that a new Office Action clearly setting forth a response to all arguments raised herein be issued and the new Office Action should be indicated as having a non-final status so that Applicants can be afforded a fair and reasonable opportunity to consider an appropriate response.

Moreover, not only is the rejection of claim 1 procedurally deficient, but it is also substantively incorrect. Not only does Chaar fail to teach or suggest the arrangement disclosed in claim 1, wherein an agent module located in a distributed element is operative to measure the operation of that distributed element, but it in fact teaches away. See, for example, column 7, lines 9-35, which clearly teaches techniques in which an availability measure of a web server is measured by a trusted third party using the Internet “ping” protocol to check if the server machines allocated to all of the SLA contracts are up. Moreover, this portion of Chaar also teaches away from the limitation wherein an agent module located in a distributed element is operative to execute a control command on that distributed element by disclosing a technique wherein an SMO executes a server allocation action via a Web server installation agent.

Dependent claims 2-20, 22-24 and 26-38 are believed allowable at least by virtue of their dependence from independent claims 1, 21 and 25, respectively. Additionally, one or more of these claims define independently patentable subject matter.

In view of the above, Applicants believe that claims 1-39 are in condition for allowance, and

respectfully request withdrawal of the §102(e) rejection.

Applicants note that both Chaar (Reel 011908, Frame 0621) and the present application (Reel 012247, Frame 0426) are currently assigned of record to International Business Machines Corporation (IBM). Furthermore, both Chaar and the claimed invention were subject to an obligation of assignment to IBM at the time the claimed invention was made. Because Chaar qualifies as prior art only under 35 U.S.C. §102(e), Applicant respectfully note that, pursuant to 35 U.S.C. §103(c), Chaar may not be used in any possible rejection under 35 U.S.C. §103(a).

Respectfully submitted,



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